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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,613

05/29/2007

Marc Peuker

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EXAMINER

PAGAN, JENINE MARIE

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

06/28/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

Office Action Summary	Application No. 10/598,613	Applicant(s) PEUKER ET AL.	
	Examiner JENINE PAGAN	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2011 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed on 4/14/2011. Claims 1-25 are pending in the application. Claim 26 is cancelled. Claims 11-19 are withdrawn from consideration.

The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action.

Drawings

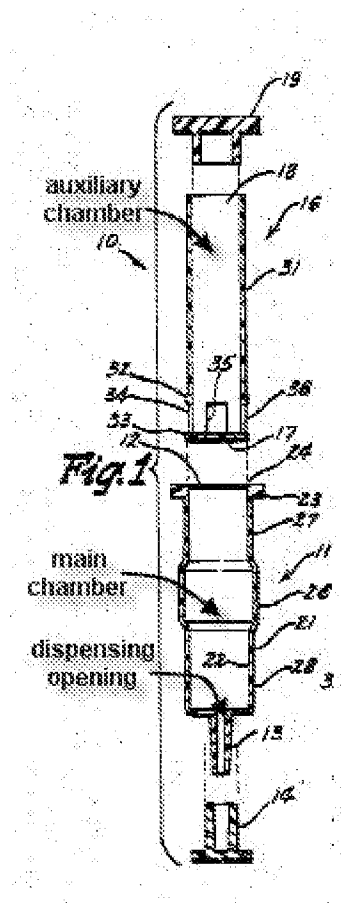
2. In light of the Applicant's amendment, the objection to the drawings is withdrawn.

Claim Rejections - 35 USC § 112

3. In light of the Applicant's amendment, the 112 rejection to the claims are withdrawn.

Claim Rejections - 35 USC § 103

4. Claims 1-10 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierick US 3,279,654 in view of Ratcliff et al. US 2,869,543.



Claim 1 and 25: Pierick discloses a kit with a capsule for storage and mixing and dispensing of material comprising a capsule body member 11 providing a main chamber (see figure above), and comprising a dispensing opening (see figure above), wherein the inner wall 22 of the capsule body member comprises a recessed area 26; an applicator member 16 adapted for slideable accommodation in said capsule body member, said applicator member providing an auxiliary chamber (see figure above), and wherein said applicator member comprises a through-hole 34/35/36 extending from the auxiliary chamber to the outer circumferential surface of the applicator member; and an activator member 19 being slideably accommodated in said applicator member; said through-hole

and said recessed area forming a channel between said main chamber and said auxiliary chamber upon activation of said capsule. (Col 3:46-50)

(When a substance is inserted into the auxiliary chamber and the activator member 19 slides into the application member 16, it will cause pressure to slide the application member toward the main chamber.)

Pierick does not specifically disclose the movement of the activator member towards the dispensing opening, causes movement of the applicator member due to hydraulic transmission.

However Ratcliff teaches that it was known in the art to have movement of an activator member 44/16 towards a dispensing opening 20, causes movement of an applicator member 14 due to hydraulic transmission.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the activator member of Pierick by extending the length to force the applicator to move toward the main chamber then to the dispensing opening due to hydraulic transmission as taught by Ratcliff, since Ratcliff suggests at Col 2:47-62 that such a modification would supply an ample amount of force to the applicator member to allow mixing of the components to be dispensed.

Claim 2: Pierick discloses radially extending through-hole 34/35/36 in said applicator member 16 is initially covered by the wall 22 of said capsule body member 11. (Col 3:20-27)

Claim 3: Pierick discloses said radially extending through-hole 34/35/36 is located in close proximity to the separation wall 17 of said applicator member 16 separating said auxiliary chamber from said mixing chamber.

Claim 4: Pierick discloses said through-hole 34/35/36 extends essentially perpendicularly to the longitudinal axis of said applicator member 16.

Claim 5: Pierick discloses said through-hole 34/35/36 extends essentially at an angle to the longitudinal axis of said applicator member 16 but it does not specifically disclose the angle being smaller than 90°.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the angle be smaller than 90°, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 6 and 7: Pierick discloses a separation wall but it does not specifically disclose the separation wall comprise a raised area extending towards said activator member comprising an annular bulge.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the separation wall of Pierick to include a raised portion with an annular bulge since it was known in the art that doing so would create an area to allow mixing of the two components.

Claim 8: Pierick discloses said applicator member 16 comprises a sealing element 32/33 sealing said through-hole 34/35/36 of said applicator member 16

against said recessed area 26 of said body member 11 and against the exterior of said capsule.

Claim 9: Pierick discloses an activator member but it does not specifically disclose the activator member comprising an activator sealing element for sealing the activator member against the applicator member.

However Ratcliff teaches that it was known in the art to provide an activator member 44/16 to comprise of an activator sealing element 42 for sealing the activator member against the applicator member 14.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the activator member of Pierick to include an activator sealing element as taught by Ratcliff, since Ratcliff suggests at Col 2:20-28 that such a modification would prevent articles from spilling out of the application member.

Claim 10: Pierick discloses sealing elements but it does not specifically disclose the sealing elements are manufactured by a two-component injection moulding process together with the capsule body member, the applicator member and said activator member.

In accordance to MPEP 2113, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Please note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product, i.e. sealing elements,

does not depend on its method of production, i.e. two-component injection moulding. In re Thorpe, 227 USPQ 964, 966 (Federal Circuit 1985).

Claim 20: Pierick discloses a dispensing cannula 13 connected to said dispensing opening.

Claim 21: Pierick discloses the dispensing cannula 13 is integrally formed with said capsule body member 11.

Claim 22: Pierick discloses a cannula but it does not specifically disclose the cannula is rotatably connected to the capsule body member thus providing a valve.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the cannula be rotatably connected to the capsule body member since it was known in the art that would allow various types of cannulas to be used for the capsule such as a needle type or a regular nozzle type.

Claim 23: Pierick discloses holding various materials but it does not specifically disclose dental material is a glass ionomer cement or a resin modified glass ionomer cement.

To have the capsule of Pierick hold the specified dental materials is considered to be intended use and the capsule of Pierick is capable of holding such materials. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not

differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim 24: Pierick discloses said main chamber contains a first, preferably powdery, component of said material 29 (Col 2:67-72), and said auxiliary chamber contains a second, preferably liquid, component of said material 37 (Col 3:20-27).

Response to Arguments

5. Applicant's arguments with respect to claims 1-10 and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3728

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENINE PAGAN whose telephone number is (571)270-3216. The examiner can normally be reached on Monday - Thursday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jenine M Pagan/
Examiner, Art Unit 3728

/Mickey Yu/
Supervisory Patent Examiner, Art Unit 3728